

Claim 1 (three-times amended). A light occlusive eye patch having an upper side and a lower side, which is provided on the lower side with a skin-compatible self-adhesive layer, consisting of a top layer, an inner layer and a black colored interlayer and all layers are made of a foamed material.

Claim 4. Please cancel

#### REMARKS

This application pertains to a novel light occlusive eye patch.

Claims 1, 3 and 5-13 are pending; claim 4 being canceled by this amendment. cl 2  
The limitations of claim 4 have been added to claim 1.

*canceled by  
amend. C  
1/17/02  
paper 21*

Claims 1 and 3-13 (now 1, 3 and 5-13) stand rejected under 35 U.S.C. 103(a) as obvious over WO '649, US '645, US '603, or US '013, each by itself or in combination.

WO 89/04649 discloses an eye patch having a backing or outer member (12) and an inner member (14). The backing member includes a polymeric film (16), a foam intermediate layer (18) and an inner adhesive layer (20) [page 5, line 1 to 11; Fig. 3].

The inner and/or outer members can be opaque (page 5, lines 28-30).

**However**, inner member (14) does not have the same shape as outer member

(12). Inner member (14) is like a wound pad (see Figure 3), which is closest to the eye. **Only the outer member, not the intermediate layer, can be opaque.**

Only the intermediate layer (18) can be foamed. The polymeric film (16) is not foamed (see page 5, line 9) and the third layer, the adhesive layer (20), is also not foamed.

Therefore, the patch of the WO 89/04649 reference includes three layers (inner member (14), intermediate layer (18), polymeric film (16) and an adhesive layer (20)). Only the intermediate layer (18) can be a foam. This layer (18) is not described as an opaque layer.

By contrast, Applicants' eye patch includes three layers (a top layer, an inner layer and a black colored interlayer) and a skin-compatible self-adhesive layer. But all layers are made of foamed material! Applicants' inner layer ensures full occlusiveness. By contrast, the inner layer (18) of WO 89/04649 is not opaque.

It is important to note that all layers of Applicants' eye patch, the top layer (1), the interlayer (2) and the inner layer (3) can be produced from a single material, which is very cost-effective (see page 5). All layers are foamed so the conformability of the eye patch and the softness of the surface are ideally suited for use on the eye (see page 5).

None of these features are taught or suggested by WO 89/04649.

US 3,908,645 discloses an ophthalmic pressure bandage formed of a patch having only one foam layer, and that one foam layer is integral to the inventive concept of this reference. Certainly, there is nothing in this reference that would suggest using three layers of foam, as Applicants have done. No advantage of doing so would be apparent from a reading of the '645 reference.

US 3,908,645 therefore neither teaches nor suggests Applicants eye patch.

US 4,538,603 concerns a wound dressing having only a single layer of foam; and the inventive concept is based on that single layer. There is nothing in the reference to suggest using three layers of foam and, indeed, any attempt to use three layers would depart from the inventive concept of this reference. Moreover, there is nothing in the reference that would suggest a three-foam-layer patch.

US 4,538,603 therefore neither teaches nor suggests Applicants eye patch.

US 5,844,013 concerns a polyurethane gel foam. The language specifically referred to by the Examiner at col. 11, lines 5-12, concerns the use of one or more thin foam layers, which are able to adhere to each other, for treatment of wounds ***without further fixation.***

This has nothing to do with an eye patch, and there is nothing in the reference that would teach or suggest the changes that would be necessary to convert the polyurethane gel foam wound treatment materials into Applicants' eye patch.

Thus, none of the cited references, taken individually, teach or suggest Applicants' novel eye patch.

While the Examiner **concludes** that these references, in combination or separately, teach the claimed invention, she has not shown **how** they could possibly do this. How or why, for example, could or would the eye patch of WO '649, the ophthalmic pressure bandage of US '645 or the wound dressing of US '603, in each of which a single-foam layer is central to their inventive concepts, be transformed into a three foamed layer eye patch, having an intermediate black colored layer, to meet Applicants' claims? What part of the teaching of any of these references would be changed, and for what reason? The Examiner does not say. What parts of each reference would the Examiner combine, and where is the suggestion to do so? The Examiner does not say.

Why would the use of a multiple thin layer polyurethane gel foam for wound treatment in the US '603 reference cause someone to go against the teachings of any or all of WO '649, US '645 or US '603 to somehow transform their teachings into a three-layer foamed eye patch, with a black colored intermediate layer? The Examiner does not say.

The identification of each of several individual concepts within the context of separate individual unrelated references does not render an invention obvious merely because one or more of such concepts can be found within the invention. There must be some driving force that would lead those skilled in the art to assemble the

component parts of the invention in a way that will arrive at the whole of the invention.

The Examiner has not shown any basis for such a motivation. Moreover, the Examiner has not even shown how or why any of the individual components she thinks she has found could or would be taken from the context within which they are disclosed in the references and reassembled to something different, namely, Applicants' invention.

Accordingly, claims 1, 3 and 5-13 have not been shown to be obvious over WO '649, US '645, US '603, or US '013, each by itself or in combination, and the rejection of said claims under 35 U.S.C. 103(a) as obvious over said references should now be withdrawn.

In view of the present amendments and remarks, it is believed that claims 1, 3 and 5 -13 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

#### CONDITIONAL PETITION FOR EXTENSION OF TIME


If any extension of time for this response is required, applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

#### ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS, McLAUGHLIN & MARCUS, P.A.

By   
William C. Gerstenzang  
Reg. No. 27,552

220 East 42nd Street, 30th Floor  
New York, New York 10017  
(212) 808-0700

1

**MARKED-UP COPIES OF AMENDED CLAIMS, SHOWING CHANGES RELATIVE TO PREVIOUS VERSION(S).**

Claim 1 (three-times amended). A light occlusive eye patch having an upper side and a lower side, [comprising at least two layers of foamed material, said at least two layers being a top layer and an inner layer; one side of said inner layer facing said top layer, and the other side of said inner layer being provided with a skin-compatible self-adhesive coating] which is provided on the lower side with a skin-compatible self-adhesive layer, consisting of a top layer, an inner layer and a black colored interlayer and all layers are made of a foamed material.